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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/662,258	2003-09-15
		First Named Inventor	
		Shih-Zheng KUO	
		Art Unit	Examiner
		2625	Steven Y. KAU
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>53,135</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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February 11, 2010

Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Shih-Zheng Kuo	Serial No.	10/662,258
Confirmation No.	9035	Filed:	September 15, 2003
Examiner:	Steven Y. Kau	Group Art Unit:	2625
For:	IMAGE COMPENSATING METHOD		
Date:	February 11, 2010		

Mailstop Appeal
Commissioner for Patents
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REQUEST AND ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

All pending claims are twice rejected in view of the Final Office Action dated October 21, 2009 and the Advisory Action dated December 29, 2009, and are therefore eligible for appeal. The final rejection of pending claims 11-10, 12-24, and 31 is appealed. References to the "Response" refer to Appellant's amendment and response after final, dated December 17, 2009.

The Examiner rejected claims 1-10, 12-24, and 31 under 35 U.S.C. § 103(a) over Lee *et al.* (U.S. Patent 6,178,015) and variously in view of Su (U.S. Patent 6,233,011), Selby (U.S. Patent 5,404,232), Horiuchi *et al.* (U.S. Patent 6,445,469), and Chien (U.S. Patent 6,480,306). The Examiner also rejected claim 19 under 35 U.S.C. § 112, paragraph 6. Grounds for appeal are as follows:

A. The Examiner Applied an Improper Standard in Responding to Appellant's Rebuttal of the Prima Facie Case of Obviousness

The Examiner asserted that by establishing "a prima facie case of obviousness," the Examiner also properly established that neither Lee nor Su teaches away from their proposed combination, that modifying Lee in view of Su does not result in an inoperable system, and that the proposed modification of Lee in view of Su is not the result of impermissible hindsight (final paragraph, page 5 of the Final Office Action).

The Appellant respectfully disagrees with the Examiner's assertions, and submits that the Examiner applied an improper methodology to reach his conclusions. Specifically, Appellant respectfully submits that the Examiner applied an incorrect standard for responding to Appellant's traversal and arguments provided in support thereof. Appellant further submits that the Examiner failed to consider all of the arguments made by Appellant. The Examiner appears to assert that establishing a prima facie case for rejection in and of itself overcomes Appellant's rebuttal arguments. Nevertheless, in contrast to the Examiner's assertion, MPEP 2145 states:

If a *prima facie* case of obviousness is established, the burden shifts to the Appellant to come forward with arguments and/or evidence to rebut the *prima facie* case...Office personnel should consider all rebuttal arguments and evidence presented by Appellants.

MPEP 2145 identifies permissible grounds for challenging the propriety of a rejection based on obviousness as: (X)(A) Impermissible Hindsight, and (X)(D) References Teach Away from the Invention or Render Prior Art Unsatisfactory for Intended Purpose. Appellant respectfully submits that the Examiner failed to explain why Appellant's arguments made in support of the above grounds are insufficient to overcome the alleged prima facie case of obviousness made by the Examiner (final paragraph, page 5 of the Final Office Action).

Per MPEP 2142, *A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself.* The Examiner's response in the Final Office Action appears to be nearly verbatim from the previous Office Action dated May 5, 2009, other than the inclusion of an alleged motivation to combine found at page 8, in rejecting claim 10. Accordingly, Appellant respectfully submits that the Final Office Action, when taken as a whole, fails to evaluate the rebuttal arguments to the prima facie case of obviousness raised by Appellant in the Response.

B. Even if combined, the references of Lee and Su fail to disclose the features.

The Examiner stated that the reference Lee discloses all the structural elements, and that Su discloses certain functional language thereof (page 4 of the Final Office Action). However, in order for the rejection on this basis to be proper, Lee's structural elements must be capable of

performing the recited functions. The Examiner acknowledged that Lee fails to disclose how the optical ruler can be used to determine a compensational gray level value (page 7 of the Final Office Action). Lee's optical ruler is scanned concurrently with scanning the document to control a position of the step motor. According to Su, 20 lines of a white plate must be scanned prior to scanning the document to determine the average value $G'(X)$ used for gray level compensation. If Su's white plate was scanned concurrently with the scanning the image, it would not be able to determine the average value $G'(X)$ beforehand. Accordingly, the combination fails to disclose the features recited, since the gray-scale values of Su's white plate must be read prior to scanning the document, and since Lee's optical ruler is unable to compensate for image brightness in a scanned image.

C. Su teaches away from the proposed combination with Lee.

According to Su, uniformity problems in a contact image sensor (CIS) result in a wide variation of voltage levels associated with scanning identical white pixels (col. 1, lines 27-43). Su solves this problem by scanning 20 lines of a white plate and taking an average value of the white levels for each of the 20 lines. Assuming Su were combined with Lee in the manner proposed by the Examiner, Su's microprocessor 36 would be unable to calculate the average white-level $G'(X)$ while scanning a first line of the image, as only one block of Lee's optical ruler would have been read. Since Su identifies that relying on a single pixel value to obtain the white value is unreliable, Su teaches away from such a combination that would require reading a single block of the optical ruler for each line of the scanned image, as taught by Lee.

D. The proposed combination of Lee and Su would render the resulting system inoperable.

By way of further example, the Examiner suggested that Lee discloses *scanning a continuous longitudinal calibration pattern while scanning the document to determine a correctional gray level value associated with the calibration pattern*, as recited by claim 1 (page 9 of the Final Office Action). The Examiner appears to be treating these recited features separately from those where Su was used to reject claim 1. Lee's gray level is used entirely for a different purpose than that disclosed by Su in scanning a white plate. Since Lee's optical ruler includes alternating white and black blocks, Su's microprocessor would only obtain white values

for the alternating white blocks. The black blocks provide zero brightness at point Pb (see Fig 3 of Lee). Accordingly, Lee's optical ruler is wholly unsuitable for compensating the gray-scale values of Su since only half the blocks (i.e. the white blocks) of Lee's optical ruler could be used to provide a calibration pattern for determining a compensational gray level.

E. The combination of Lee with Su requires the use of Impermissible Hindsight

Su operates similarly as described in Appellant's Background, where a calibration plate is scanned prior to scanning a document. Appellant respectfully submits that combining the references in the manner proposed by the Examiner would only be obvious with the benefit of impermissible hindsight and in view of Appellant's own specification. There is no teaching that suggests that the alternating white and black block optical ruler of Lee could be replaced or substituted with the white plate of Su, or that the white plate of Su could be replaced or substituted with the optical ruler of Lee.

F. Proceeding Contrary to Accepted Wisdom Is Evidence of Nonobviousness.

Appellant respectfully submits that in each of the references (e.g. Chien, Selby, and Su) previously cited by the Examiner as allegedly disclosing determining *a correctional gray level value based at least in part on a scanned image of the reference pattern*, the calibration plate is initially scanned before the document itself is scanned. This is further consistent with Figure 1 of Appellant's Background which shows a pattern 116 positioned in a transverse position. MPEP 2145 (X)(D)(3) states that "The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness." Appellant respectfully submits, consistent with MPEP 2145 (X)(D)(3), that the Examiner's suggestion that the use of a plate oriented similarly as the optical ruler of Lee would be contrary to the accepted wisdom of the references which describe a transverse positioned calibration plate. This follows since Lee's optical ruler is unrelated to any determination of correctional gray levels, as acknowledged by the Examiner (page 7 of the Final Office Action).

G. The Examiner failed to examine claim 19 as required under 35 U.S.C. § 112, paragraph 6.

In rejecting claim 19, the Examiner stated that he does not consider claim 19 to meet the

3-prong requirement. Appellant respectfully submits that the Examiner failed to allege which of the 3-prong requirements have not been met. Furthermore, Appellant respectfully submits that each of the “means for” recitations should be analyzed under 35 U.S.C. § 112, paragraph 6 where the recited features meet the 3-prong requirement. According to 35 U.S.C. 112,

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

It appears that the Examiner instead categorically determined the claim as a whole fails to meet the 3-prong requirement, and therefore refused to examine any of the claim features as required therein. This contradicts the above statutory requirement which indicates that the means plus function analysis is required if an element is expressed as a means for performing a specified function. Appellant respectfully submits that claim 19 recites such means that meet the 3-prong requirement identified by the Examiner.

The Appellant asserts all arguments made previously during prosecution of this application, whether or not explicitly discussed herein, and preserves the right to include these arguments in the Appeal Brief and Reply Brief, as appropriate. Appellant respectfully requests that these prior arguments be read and understood in light of the above mentioned grounds for appeal.

Customer No. 73552

Respectfully submitted,

STOLOWITZ FORD COWGER LLP

A handwritten signature in dark ink, reading "Bryan Kirkpatrick", written over a horizontal line.

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